

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/757,151  
Applicants : Michael P. Casey *et al.*  
Filed : January 14, 2004  
Title : Gaming Machine Having A Shuffle Feature And  
: A Simultaneous Multiple Award Feature  
TC/A.U. : 3714  
Examiner : Andrew Kim  
Docket No. : 247079-000292USPT  
Customer No. : 70243

MS After Final (via EFS)  
Commissioner for Patents  
Alexandria, Virginia 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In the Final Office Action dated February 7, 2008, all the independent claims (claims 22, 33, and 43) were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,347,996 to Gilmore *et. al.* (“Gilmore”).

**I. THE BACKGROUND OF THIS PENDING APPLICATION**

**A. First Office Action**

All the independent claims were rejected in the first Office Action, dated July 9, 2007, as allegedly being anticipated by U.S. Patent No. 6,015,346 to Bennett (“Bennett”). Bennett merely teaches that a player can receive an award if a single pair of matching cards is revealed, wherein the award is equal in amount to the value of the matching cards. For example, referring to FIG. 3 of Bennett, a player would have received an award of \$10 (card 41) if card 48 would have revealed “\$10” instead of “\$50”. Alternatively, a “Wild” symbol on card 48 would have also resulted in an award of “10”. To advance prosecution, the Applicants submitted proposed claim amendments in September, 2007, to further distinguish the pending claims from Bennett.

A personal interview was conducted with Examiner Hotaling and Examiner Kim on October 18, 2007. One topic of discussion during the interview generally focused on clarifying that the claims were directed to awarding multiple awards if a wild icon was revealed subsequent to revealing two different pairs of game-theme icons. The Applicants’ representatives referred to FIG. 18 of the pending application to more clearly explain one

exemplary embodiment. Specifically, the exemplary embodiment shows a first group of tiles 651, 654 having a matching first game-theme icon “Gene” and a second group of tiles 652, 655 having a matching second game-theme icon “Debbie.” Only after the revealing of these two groups of tiles (each having its own matching game-theme icon), and the revealing of a wild icon (*e.g.*, tile 657), will the player receive the multiple awards (*e.g.*, 20 free spins for the “Gene” pair and 15 free spins for the “Debbie” pair).

Pursuant to the interview discussions, the Applicants filed a Response to the Office Action on October 29, 2007. In the Response, the Applicants amended the independent claims to further clarify that multiple awards are awarded in response to revealing a wild icon subsequent to revealing two pairs of game-theme icons, each pair including its own matching game-theme icons (*e.g.*, first tiles having a “Gene” game-theme icon and second tiles having a “Debbie” game-theme icon).

#### **B. Final Office Action**

In the Final Office Action, agreeing that Bennett fails to disclose the pending claims, all the independent claims were instead rejected based on Gilmore (which is assigned to WMS Gaming, Inc., the same assignee as the pending application). Gilmore generally discloses a game in which a portion of a map, which is initially concealed by a plurality of tiles, is revealed upon the player selecting 3 matching tiles. For example, referring to FIG. 6, if the player selects two more “moose head” tiles to match them to the revealed “moose head tile” on the screen, the corresponding map portion will be revealed. Optionally, revealing a “Wild” tile subsequent to the revealing of a pair of matching tiles, will automatically select the third matching tile.

The Applicants filed a Response to the Final Office Action on May 6, 2008. In this Response, the Applicants respectfully noted that Gilmore does not appear to provide any more support to the rejections than Bennett. The “Wild” tile matching of Gilmore is only directed to a single group of tiles, and it closely resembles Bennett’s game in which a wild symbol was selected as one of a single pair of cards. In contrast to both Gilmore and Bennett, the pending claims are directed to matching a wild icon with tiles of at least two groups of game-theme icons. None of Gilmore and Bennett discloses awarding simultaneous awards based on two different groups of tiles in response to revealing a wild icon.

### C. Advisory Action

An Advisory Action, dated May 22, 2008, stated that the request for reconsideration does not place the application in condition. As explained in more detail below, the reasoning of the Advisory Action confuses claim elements and it is not supported by Gilmore.

## II. THE CLAIMED TWO GROUPS OF GAME-THEME ICONS ARE DIFFERENT

The Advisory Action alleges that

... the two groups of the instant application are not claimed as such that the two groups are entirely different. That is, it has been interpreted that one or more tiles of one group may be a tile(s) for another group. Say there are 4 tiles: 1, 2, 3, 4. 1, 2 and 3 (group B) are matching tiles and 4 is the wild. Player picks tiles 1 and 2 (group A). Then the player picks tile 4 (the wild) which reveals tile 3 (which completes group B) and uncovers the picture from underneath all 4 tiles (simultaneous award).

(Emphasis added). The claim language of each of the independent claims is clear that the two groups are different. In fact, claim 22 actually includes specific claim language stating that “**the second group [is] different from the first group.**” In view of this clear language, the allegation that the two groups are “not claimed as such that the two groups are entirely different” is entirely without merit.

Furthermore, each of the independent claims (as amended based on conversations with the Examiners) further provides details to clarify that the matching game-theme icons of a first group of tiles are different than the matching game-theme icons of a second group. For ease of understanding, relevant claim elements are generally described below by referring to FIG. 18 of the pending application:

- a first group of tiles having at least two first tiles (*e.g.*, tiles 651 and 654)
  - each of the first tiles having a first game-theme icon (*e.g.*, “Gene”)
  - the first game-theme icons are matching (*e.g.*, “Gene”) icons
- a second group of tiles having at least two second tiles (*e.g.*, tiles 652 and 655)
  - each of the second tiles having a second game-theme icon (*e.g.*, “Debbie”)

- the second game-theme icons are matching (*e.g.*, “Debbie”) icons

In its example, the Advisory Action assumes that tiles 1 and 2 can be part of both group A and group B. However, the claim elements of the pending claims are clear that the tiles of one group cannot be part of another group (*i.e.*, “each of the first tiles having a first game-theme icon, the first game-theme icon from one of the first tiles matching the first game-theme icon from another one of the first tiles” and “each of the second tiles having a second game-theme icon, the second game-theme icon from one of the second tiles matching the second game-theme icon from another one of the second two tiles”). For example, tiles 651 and 654 having the “Gene” icon can only be part of one group (*e.g.*, the “Gene” icon group), and tiles 652 and 655 can only be part of another group (*e.g.*, the “Debbie” icon group). Based on the reasoning of the Advisory Action, for example, the “Gene” tiles 651 and 654 can be part of both the “Gene” icon group and the “Debbie icon group. Clearly, the claim language does not allow this interpretation.

As explained earlier, Gilmore (similar to Bennett) only discloses that the “Wild” tile can match a single group of tiles. Thus, the Applicants do not understand how Gilmore can support the allegation of the Advisory Action that a pair of tiles can belong to two different groups.

Moreover, the Applicants do not understand how the argument that a pair of tiles can belong to two different groups is applicable to the pending claims. The pending claims are clearly drafted such that a pair of tiles can only belong to one group.

### **III. REVEALING OF MAP IS NOT AN AWARD**

The Advisory Action also alleges that the picture from underneath all 4 tiles is a “simultaneous award.” Apparently, the Advisory Action is confusing the revealing of a portion of the map (which corresponds with a respective matching tile) to an award. Thus, according to the Advisory Action, revealing two portions of the map would correspond to two awards. The comparison of awards to revealing map portions is incorrect.

The pending claims are generally directed the simultaneous awarding of a first award (based on the first tiles of the first group) and a second award (based on the second tiles of the second group). For example, referring to FIG. 18 of the pending application, a first award can be 20 free spins (based on the “Gene” tiles 651 and 654) and a second award can

be 15 free spins (based on the “Debbie” tiles 652 and 655). Similarly, as another example, claim 28 clarifies that the award can be a number of free reel spins, and claim 32 clarifies that the award can be a credit amount.

Gilmore’s examples of awards are consistent with the examples of the pending application. For example, Gilmore discloses that “the bonus feature could award a bonus for a particular mining spot on the mining map only if that mining spot is revealed upon removal of one of the matches.” Gilmore, col. 5, ll. 23-25 (emphasis added). Gilmore does not refer to the revealing of the map as being an award, but to the bonus being an award. The bonus, for example, can be “a nominal bonus ranging from 10 to 200 times the player’s line bet.” Gilmore, col. 4, ll. 50-53. In another example, Gilmore discloses that a “pick is rewarded each time three matching tiles are selected.” Gilmore, col. 4, ll. 23-24. None of these examples refer to awarding the player by revealing the map.

Thus, the Applicants are confused as to why the Advisory Action (and the Final Office Action) refers to the revealing of the map as being an award. Gilmore, as well as the pending application, does not support this type of interpretation.

#### IV. CONCLUSION

It is the Applicants’ belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

A Notice of Appeal is hereby made. Please charge the corresponding \$510 Notice of Appeal fee to Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000292USPT.

Respectfully submitted,

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